



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,806	10/06/2003	Wen-Peng Liu	P26,257-C USA	3311
23307	7590	03/21/2005	EXAMINER	
SYNNESTVEDT & LECHNER, LLP 2600 ARAMARK TOWER 1101 MARKET STREET PHILADELPHIA, PA 191072950			ASINOVSKY, OLGA	
		ART UNIT		PAPER NUMBER
				1711

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

11

Office Action Summary	Application No.	Applicant(s)	
	10/679,806	LIU ET AL.	
	Examiner Olga Asinovsky	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
 - 4a) Of the above claim(s) 16-22 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/13/04 & 01/31/05</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claim 1-15 in the reply filed on January 21, 2005 is acknowledged.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/679,871 in view of Parish et al U.S. patent 5,891,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications recite a curable adhesive composition comprising polymerizable vinyl ester comprising the reaction product of a compound containing an ethylenically unsaturated group with epoxy compound, curing catalyst and an activator.

4. The difference is that the present claims include reactive multifunctional acrylate. A multifunctional acrylate is a polymerizable compound.

Parish discloses that a multifunctional acrylate compound has a benefit to increase the crosslink density of the coating, column 3, line 56. It would have been obvious to one of ordinary skill in the art to expect the presence of said multifunctional acrylate in a curable adhesive composition in claims 1-15 of application No'871 to increase adhesive properties of the adhesive composition, support of that can be found in Parish'5,891,942 at column 3, line 56.

5. This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 rejected under 35 U.S.C. 102(b) as being anticipated by Mani U.S. patent 3,816,283.

8. Mani discloses a polymerizable vinyl ester compound; ethylenically unsaturated monomer such as (meth)acrylic acid, vinyl nitrile monomer or methyl acrylate, or butyl acrylate; a multifunctional acrylate such as ethylene glycol dimethacrylate or trimethylol propane trimethacrylate, column 3, lines 10-25; curing catalyst including particulate accelerator effective by ionizing radiation, and activator such as amines, column 3, lines 62-63 and column 4, lines 1-40.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parish et al U.S. patent 5,891,942 in view of Liu et al U.S. patent 5,096,783 .

11. Parish discloses a coating composition based on vinyl ester resin and a reactive diluent comprising a mixture of difunctional acrylate compound and/or multifunctional acrylate compound and a monofunctional acrylate compound and a reactive diluent such as vinyl toluene; a catalyst component such as a free radical initiator, and an accelerating agent=activator including dimethylaniline, column 5, lines 1-10 and 51-54. Parish does not disclose polymerizable vinyl ester comprises the reaction product of an epoxy compound and a compound containing an ethylenically unsaturated group represented in the present claim 8.

Liu discloses polymerizable epoxy vinyl ether compound represented by the structure at column 3, line 52. The epoxy vinyl ether compound is the reaction product of an ethylenically unsaturated monomer and epoxy compound, column 2, lines 57-59. This compound is readable in applicants' claim 8. The epoxy vinyl ether compound can be mixed with polymerizable alkenyl ester and acrylate monomers, column 3, lines 67-68. It would have been obvious to one of ordinary skill in the art to modify a coating composition in Parish by employing a polymerizable epoxy vinyl ether compound of Liu

invention for the purposes of being an additional polymerizable compound having epoxy terminated groups for increasing the curing effect and adhesive properties, and since an addition compound for increasing the curing effect for a coating composition in Parish would be expected.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. References have been considered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 571-272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Olga Asinovsky
Examiner
Art Unit 1711

C.A
March 7, 2005



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700